

## PATENT COOPERATION TREATY

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## INTERNATIONAL PRELIMINARY EXAMINATION REPORT

(PCT Article 36 and Rule 70)

Applicant's or agent's file reference Green 1-22-1	<b>FOR FURTHER ACTION</b> <span style="float: right;">See Notification of Transmittal of International Preliminary Examination Report (Form PCT/IPEA/416)</span>	
International application No. PCT/GB98/01721	International filing date (day/month/year) 12/06/1998	Priority date (day/month/year) 14/06/1997
International Patent Classification (IPC) or national classification and IPC H04Q11/04		
<p><b>Applicant</b> NORTHERN TELECOM LIMITED et al.</p>		
<p>1. This international preliminary examination report has been prepared by this International Preliminary Examining Authority and is transmitted to the applicant according to Article 36.</p> <p>2. This REPORT consists of a total of 7 sheets, including this cover sheet.</p> <p><input checked="" type="checkbox"/> This report is also accompanied by ANNEXES, i.e. sheets of the description, claims and/or drawings which have been amended and are the basis for this report and/or sheets containing rectifications made before this Authority (see Rule 70.16 and Section 607 of the Administrative Instructions under the PCT).</p> <p>These annexes consist of a total of 2 sheets.</p>		
<p>3. This report contains indications relating to the following items:</p> <ul style="list-style-type: none"> <li>I <input checked="" type="checkbox"/> Basis of the report</li> <li>II <input type="checkbox"/> Priority</li> <li>III <input type="checkbox"/> Non-establishment of opinion with regard to novelty, inventive step and industrial applicability</li> <li>IV <input type="checkbox"/> Lack of unity of invention</li> <li>V <input checked="" type="checkbox"/> Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement</li> <li>VI <input type="checkbox"/> Certain documents cited</li> <li>VII <input checked="" type="checkbox"/> Certain defects in the international application</li> <li>VIII <input checked="" type="checkbox"/> Certain observations on the international application</li> </ul>		

Date of submission of the demand 23/11/1998	Date of completion of this report 19.07.99
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**INTERNATIONAL PRELIMINARY  
EXAMINATION REPORT**

International application No. PCT/GB98/01721

**I. Basis of the report**

1. This report has been drawn on the basis of (*substitute sheets which have been furnished to the receiving Office in response to an invitation under Article 14 are referred to in this report as "originally filed" and are not annexed to the report since they do not contain amendments.*):

**Description, pages:**

1-8 as originally filed

**Claims, No.:**

1-6,7 (part) as originally filed

7 (part),8,9 as received on 23/11/1998 with letter of 28/08/1998

**Drawings, sheets:**

1/2 as originally filed

2/2 as received on 23/11/1998 with letter of 28/08/1998

2. The amendments have resulted in the cancellation of:

the description, pages:  
 the claims, Nos.:  
 the drawings, sheets:

3.  This report has been established as if (some of) the amendments had not been made, since they have been considered to go beyond the disclosure as filed (Rule 70.2(c)):

4. Additional observations, if necessary:

**see separate sheet**

**INTERNATIONAL PRELIMINARY  
EXAMINATION REPORT**

International application No. PCT/GB98/01721

**V. Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement**

**1. Statement**

Novelty (N)	Yes: Claims 1-9
	No: Claims
Inventive step (IS)	Yes: Claims
	No: Claims 1-9
Industrial applicability (IA)	Yes: Claims 1-9
	No: Claims

**2. Citations and explanations**

**see separate sheet**

**VII. Certain defects in the international application**

The following defects in the form or contents of the international application have been noted:

**see separate sheet**

**VIII. Certain observations on the international application**

The following observations on the clarity of the claims, description, and drawings or on the question whether the claims are fully supported by the description, are made:

**see separate sheet**

**INTERNATIONAL PRELIMINARY  
EXAMINATION REPORT - SEPARATE SHEET**

International application No. PCT/GB98/01721

**Concerning Point I**

The applicant failed to confirm if the listed application documents are correct, since this is not obvious from the file contents.

In this respect it is noted that the receiving office (not the EPO) informed the applicant of defects with letter dated 01.07.98. These included the opinion (not shared by the examining authority) that the originally filed drawings contained excess text matter. This the applicant apparently "corrected" by filing a new drawing sheet 2 with letter dated 28.08.98 containing far more text matter!

Additionally, the applicant filed a new page 10 comprising part of claim 7 and claims 8 and 9. There seems to be no new difference between this page and the originally filed page. This is just as well, since otherwise this would constitute an amendment, and not a correction of a defect under Article 14 PCT.

**Concerning Point V**

1) The following documents are cited:

D1 ZAHARIADIS T ET AL: "Internet access over residential ATM networks" BROADBAND STRATEGIES AND TECHNOLOGIES FOR WIDE AREA AND LOCAL ACCESS NETWORKS, BERLIN, GERMANY, 10-11 OCT. 1996, vol. 2953, pages 98-106 Proceedings of the SPIE - The International Society for Optical Engineering, 1996, SPIE-Int. Soc. Opt. Eng, USA

D2 BALDWIN J H ET AL: "AAL-2 - A NEW ATM ADAPTION LAYER FOR SMALL PACKET ENCAPSULATION AND MULTIPLEXING" BELL LABS TECHNICAL JOURNAL, vol. 2, no. 2, 21 March 1997, pages 111-131

D3 KISHIMOTO R: "AGENT COMMUNICATION SYSTEM FOR MULTIMEDIA COMMUNICATION SERVICES" PROCEEDINGS OF IEEE INFOCOM 1996. CONFERENCE ON COMPUTER COMMUNICATIONS, FIFTEENTH ANNUAL JOINT CONFERENCE OF THE IEEE COMPUTER AND COMMUNICATIONS SOCIETIES. NETWORKING THE NEXT GENERATION SAN FRANCISCO, MAR. 24 - 28, 1996, vol. 1, no. CONF. 15, 24 March 1996, pages 10-17 INSTITUTE OF ELECTRICAL AND ELECTRONICS ENGINEERS

**INTERNATIONAL PRELIMINARY  
EXAMINATION REPORT - SEPARATE SHEET**

International application No. PCT/GB98/01721

D4 WO 97 19565 A

D5 THOM G A: "H. 323: THE MULTIMEDIA COMMUNICATIONS STANDARD FOR LOCAL AREA NETWORKS" IEEE COMMUNICATIONS MAGAZINE, vol. 34, no. 12, December 1996, pages 52-56

D6 MOWAFFAK T MIDANI ET AL: "INTRODUCING THE V PROTOCOL FOR THE INTERACTIVE VIDEO NETWORK" ANNUAL REVIEW OF COMMUNICATIONS, vol. 49, 1 January 1996, pages 589-598

- 2) Since, partly owing to the wording, not explicitly derivable from a single document, the application as claimed is novel, and also industrially applicable, within the meaning of Articles 33(1), (2) and (4) PCT.
- 3) However, the application as per independent claims 1 and 7 essentially relates to connecting to the Internet via an ATM network. This is, however, known from D1 (see in particular figure 4 but also other passages cited in search report plus abstract and introduction).

Although claims 1 and 7 are a bit strangely worded, it is thus clear that from the starting point of D1 the skilled man could arrive at the claimed subject matter without performing an inventive step (Article 33(3) PCT). These claims thus fail to meet the requirements of Article 33(1) PCT in this regard.

- 4) Similar comments to the above also apply to independent claim 8. Claim 8 additionally claims a shared set top box. Although D1 discloses a set top box (second paragraph of introduction) It is not clear if this is shared or not. This obvious feature is, in any case, known from D4 (page 3 lines 2 - 24 and figures 1 and 2 and related parts of the description).

From the starting point of D1 and either applying his general knowledge or from his knowledge of D4 the skilled man can thus arrive at the subject matter of claim 8 without performing an inventive step (Article 33(3) PCT). This claim thus fails to meet the requirements of Article 33(1) PCT in this regard.

**INTERNATIONAL PRELIMINARY  
EXAMINATION REPORT - SEPARATE SHEET**

International application No. PCT/GB98/01721

5) The additional features of dependent claim 2 are known from D1.

The additional features of dependent claim 3 are known from D2 and of dependent claim 4 from D2 in the light of D4.

The additional features of dependent claims 5, 6 and 9 relating to call setup and signalling relate to design feature that obviously have to exist for the system to function. In any case, they are derivable from D2 (figure 2 and related parts of text; page 116 right column 2nd paragraph) or D5 (page 55 "call models and call setup").

None of the dependent claims thus adds anything to their respective dependent claims which would require the skilled man to perform an inventive step (Article 33(3) PCT). These claims thus fail to meet the requirements of Article 33(1) PCT in this regard.

6) It is further noted that all features of the current application seem to be well known, for example from D1, D2 or D5. The arrangement described in the current application comprises merely a non-inventive juxtaposition of these well known features functioning in their normal manner without producing any non-obvious working inter-relationship (see also PCT Guidelines PCT/GL/3 IV 8.8(B1)).

**Concerning Point VII**

- 1) The independent claims should have been put in the two part form recommended by Rule 6.3(b) PCT with a pre-characterising part reflecting the teachings of the closest prior art.
- 2) In order to meet the requirements of Rule 6.2(b) PCT reference signs in parenthesis should have been added to the claims. This applies both to the preamble and to the characterising part.
- 3) In order to meet the requirements of Rule 5.1(a)(ii) PCT, the most relevant couple of search report documents, and at least the document D1 should have been cited in the description and briefly discussed.

**INTERNATIONAL PRELIMINARY  
EXAMINATION REPORT - SEPARATE SHEET**

International application No. PCT/GB98/01721

**Concerning Point VIII**

- 1) The phrase in claim 7 "to effect access of said packet network to services provided by said service provider network" seems not to be correct.
- 2) Mentions of "spirit" or similar should have been deleted from the last paragraph of the description (cf. PCT Guidelines PCT/GL/3 III 4.3a).
- 3) As pointed out in section I above, sheet 2 of the drawings (now) contains too much text matter.

-10-

5 a circuit switched network provided intermediate said packet and service provider networks, the method including transmitting said service traffic via a distributed gateway providing an interface between said circuit switched network and said service provider and packet networks whereby to effect access of said packet network to services provided by said service provider network.

10 8. A distributed gateway for a communications network configuration comprising a packet network to which a plurality of terminals are connected, a service provider network, a circuit switched network provided intermediate said packet and service provider network, said distributed gateway incorporating a shared set top unit for said terminals and a network interface unit whereby to effect access of said packet network to services provided by said service provider network.

15 9. A distributed gateway as claimed in claim 8, and further incorporating a telephony service manager for establishing calls between said terminals and said service provider network.

2/2

